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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,869	08/30/2001	Pascal Arnaud	212527US0	7528

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EXAMINER

BAHAR, MOJDEH

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/23/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,869

Applicant(s)

ARNAUD, PASCAL

Examiner

Mojdeh Bahar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 53-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: |

Detailed Action

Applicant's response to the restriction requirement submitted January 24, 2003 is acknowledged.

Applicant's election with traverse of the invention of Group I, claims 1-52, and poly(hydroxy-12) stearic acid as the specific dispersant and octyldodecy neopentanoate as a specific non-volatile hydrocarbon in Paper No. 6 submitted January 24, 2003 is acknowledged. Applicant states that the office has failed to meet the burden necessary to sustain the restriction requirement showing that the two groups although related as product and process of use, are drawn to distinct inventions. As reasoned in the Restriction Requirement of 09/24/2002, the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case skin or lips could be cared for by a composition consisting of petroleum jelly. Therefore the process can be practiced with a product (i.e., petroleum jelly) that is materially different from the instant product (i.e., a composition comprising a non-volatile hydrocarbon based oil, a non-volatile silicone compound, an inert particulate phase and a dispersant).

Applicant also states that Groups I and II have a substantially co-extensive search. Note that the search for the claimed composition is not coextensive with the search for the method of using the composition. Any composition comprising the same ingredients as the instant composition, regardless of its intended use, can be used as prior art for the composition claims. However, this does not hold true for the method of use claims. Note further that the search is not

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limited to patent files. Please note that the restriction requirement between the product and process of use herein is deemed proper as distinctness among these inventions has been shown under MPEP 806.05(h) in the restriction requirement mailed September 24, 2002.

Because the considerations as to patentability are individual to each Group herein and the burden of search for all inventions is undue, as discussed herein and in the restriction requirement, the restriction requirement is maintained.

In regard to the specie election note the following: Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-52 are herein examined on the merits in so far as they read on the elected species as well as isononyl isonoanoate (non-volatile hydrocarbon) and diisoarachidyl dilinoleate (i.e., dispersant).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the expression "care...composition". The meaning of this

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expression is not clear. One of ordinary skill in the art does not know what is designated by this expression and thus the metes and bounds of the claims (claim 1 and all claims dependent thereon) cannot be ascertained. The expression “cosmetic actives” in claim 35 and 38 renders these claims indefinite. Note that by definition a cosmetic active is physiologically neutral. Therefore “cosmetic active” is vague and fails to clearly define the metes and bounds of the claim. Claim 37 contains the expression “pasty” which renders the claim indefinite. One of ordinary skill in the art would not know what is meant by “pasty”. What is the viscosity of the composition? How is “pasty” defined?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-10, 11,18, 29-31, 35-40, 42-43, 46, 48, 50-52 are rejected under 35

U.S.C. 102(b) as being anticipated by Jacks et al. (USPN 5,690,918).

Jacks et al. (USPN 5,690,918) a cosmetic lipstick composition comprising a non-volatile hydrocarbon oil (isononyl isonanoate, MM 284.48 g/mole), a non-volatile silicone polymer, 1.9 % mica and acrylate copolymer (i.e., particulate), dyestuff 10% by weight (e.g., Red & Red 6), diisoarachidyl dilinoleate (i.e., dispersant), and paraffin, see example 2 in col. 8 and claims 1-9.

Claims 1-10, 24-30, 32, 33, 35, 37-43, 45-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Mellul et al. (USPN 5,738,841).

Mellul et al. (USPN 5,738,841) discloses a cosmetic lipstick composition comprising 60 % octyldodecyl neopentanoate (the elected specie of non-volatile hydrocarbon oil), 0.1 diphenyldimethicone, 5% alkyldimethicone (silicone compounds), a total of 18 % of polyethylene and microcrystalline waxes and 12% pigments, see examples 5 and 6 and claims 1-18. Mellul also teaches that its product further contains lamellar or non-lamellar, spherical or non-spherical fillers as well as other fillers, see claims 11-15 in particular. Mellul finally teaches that the composition is in anhydrous form, see claim 1 in particular.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 34 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul et al. (USPN 5,738,841).

Mellul et al. (USPN 5,738,841) discloses a cosmetic lipstick composition comprising 60 % octyldodecyl neopentanoate (the elected specie of non-volatile hydrocarbon oil), 0.1

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diphenyldimethicone, 5% alkyldimethicone (silicone compounds), a total of 18 % of polyethylene and microcrystalline waxes and 12% pigments, see examples 5 and 6 and claims 1-18. Mellul also teaches that its product further contains lamellar or non-lamellar, spherical or non-spherical fillers as well as other fillers, see claims 11-15 in particular. Mellul finally teaches that the composition is in anhydrous form, see claim 1 in particular.

Mellul does not particularly teach the weight percentages claimed herein.

It would have been obvious to employ the weight percentages herein in the composition of Mellul.

One of ordinary skill in the art would have been motivated to employ the weight percentages herein in the composition of Mellul because the optimization of amounts is within the skill of the artisan and is therefore obvious.

Claims 11-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul as applied to claims 34-44 above, and further in view of JP 63119412 abstract.

Mellul does not particularly teach the employment of poly(hydroxy-12) stearic acid in its lipstick composition.

JP 63119412 abstract teaches that 12-hydroxystearic acids are known to be useful in makeup sticks.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ 12-hydroxystearic acids in the composition of Mellul.

One of ordinary skill in the art would have been motivated to employ 12-hydroxystearic acids in the lipstick composition of Mellul because 12-hydroxystearic acids are known to be useful in cosmetic lipstick compositions.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Claims 11-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,326,012 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 is encompassed by claims 11-13 herein.

Claims 6, 12-14, 16, 18-20, 24-25, 28-29, 32, 35-39, 48-49, 51-52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the corresponding claims 16, 1-3, 4, 5-7, 10-11, 12-13, 19, 14, 20-23, 24-25, 26-27 of copending Application No. 09/728,056. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the co-pending application encompass many, if not all, of the same compositions claimed herein.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claims 1,11, 28, 35, 37, 38, 48-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29, 32-34, 36 of U.S. Patent application No. 08/643,360. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S. Patent application No. 08/643,360 are encompassed by the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mojdeh Bahar whose telephone number is (703) 305-1007. The examiner can normally be reached on (703) 305-1007 from 8:30 a.m. to 6:30 p.m. Monday, Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Mojdeh Bahar
Patent Examiner
April 10, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER 4/18/03